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10/790,846	03/03/2004	Zoran Pavlovic	13180-13	2496

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EXAMINER

MULLEN, KRISTEN DROESCH

ART UNIT

PAPER NUMBER

3766

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,846

Applicant(s)

PAVLOVIC ET AL.

Examiner

Kristen Mullen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/29/05 (DS).
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 and 23-28 is/are rejected.
7) ☒ Claim(s) 21 and 22 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/15/04, 6/29/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Abstract

1. The abstract of the disclosure is objected to because it is over 150 words in length.

Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Specification

3. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, *if* the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 40. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add

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the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 17 is objected to because of the following informalities: the word --part-- is missing after the second instance of "body" in line 2. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is an abstract idea and does not result in a concrete, useful and tangible result. See MPEP 2106 II A.

8. Claims 25-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 25 describes a system including electrodes applied to a first body part. Since the human body is positively recited in the claim, non-statutory subject matter has been claimed. See Commissioner Quigg's notice at 1077 OG 24 (April 21, 1987).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3-4, 16-17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward et al. (2002/0161311).

Regarding claim 1, Ward shows a method including obtaining a prebalancing factor (C_f , C_n) from a population group to account for variability between the first body part and the second body part, measuring an electrical property of at least one of the first body part and the second body part with an electrode array (24, 25, 24A, 25A); and utilizing the prebalancing factor (C_f , C_n) to prebalance the electrical property (Paras. [0069]-[0072], [0076]-[0079]).

With respect to claim 17, Ward shows a system comprising: a prebalancing factor module (35, 40); an electrode array (28, 29, 28A, 29A) and a prebalancing module (35, 40).

Regarding claims 3 and 19-20, Ward shows the electrode array includes a plurality of current injection electrodes (24, 25, 24A, 25A) and a plurality of voltage measurement electrodes (28, 29, 28A, 29A) (Fig. 5).

With respect to claim 4, Ward further shows the electrical property is electrical impedance, and injecting currents into the first body part with the plurality of current injection electrodes (24, 25), measuring a set of impedances with the plurality of voltage measurement electrodes (28, 29), injecting currents into the second body part with the plurality of current

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injection electrodes (24A, 25A), and measuring a set of impedances with the plurality of voltage measurement electrodes (28A, 29A).

Regarding claim 16, Ward further shows utilizing the electrical property after prebalancing to diagnose the possibility of disease in one of the first body part and the second body part (Paras. [0078]-[0079]).

11. Claims 1-2, 16-17 and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Nachaliel (2002/0183645).

Regarding claim 1, Nachaliel shows a method including obtaining a prebalancing factor (F_b) from a population group to account for variability between the first body part and the second body part (Paras. [0126], [0162], [0174], [0181], [0191]), measuring an electrical property (r) of at least one of the first body part and the second body part with an electrode array (Fig. 2); and utilizing the prebalancing factor (F_b) to prebalance the electrical property ($r = F_b \times r$) (Paras. [0162]).

With respect to claim 17, Nachaliel shows a system comprising: a prebalancing factor module (110); an electrode array (106) and a prebalancing module (110) (Paras. [0162], [0174], [0181], [0191]).

Regarding claims 2 and 18, Nachaliel shows the first and second body parts are breasts (Paras. [0174], [0191]).

Regarding claim 16, Nachaliel further shows utilizing the electrical property after prebalancing to diagnose the possibility of disease in one of the first body part and the second body part (Para. [0191]).

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With respect to claims 23-24, Nachaliel shows a normalizing factor calculation module (110) (Paras. [0118], [0138], [0146]) and Nachaliel shows the electrode array is used (Fig. 2).

Regarding claim 25, Nachaliel shows n_e measurement electrodes (106) (Fig. 2).

With respect to claim 26, Nachaliel shows a specific impedance calculation module (110) (Paras. [0150]-[0193]).

The statements of intended use have been carefully considered but are not considered to impart any further structural limitations over the prior art. Examples of statements of intended use are:

- “for prebalancing an electrical property obtained from at least one of a first body part and a second substantially similar body (part)”,
- “for obtaining a prebalancing factor (PBF) from a population group to account for variability between the first body part and the second body part”,
- “for measuring an electrical property of at least one of the first body part and the second body part”,
- “for utilizing the prebalancing factor to prebalance the electrical property”,
- “for obtaining sets of normalizing factors to account for variability within the first and second body parts”,
- “used to obtain a set of impedances from the first body part and a set of impedances from the second body part, which, together with the sets, yield a set of normalized impedances for the first body part, and a set of normalized impedances for the second body part”,

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- “for obtaining the prebalancing factor after averaging of a subset of and a subset of the subsets formed by omitting normalized impedances that could correspond to anomalous electrical pathways”, etc.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al. (2002/0161311) as applied to claims 1 and 17 above. Ward is as explained before. Although Ward fails to specifically show the first and second body parts are breasts, it would have been obvious to one with ordinary skill in the art at the time the invention was made to utilize the method of Ward to monitor the breasts for edema.

Allowable Subject Matter

14. Claims 21-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen Mullen whose telephone number is (571) 272-4944. The examiner can normally be reached on M-F, 10:30 am-6:30 pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kristen Mullen
Patent Examiner
Art Unit 3766

kdm

A handwritten signature in black ink that reads "Kristen Mullen". The signature is written in a cursive, flowing style.